

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 2-10, 14, 26, 27, 30, and 31 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate status identifier.

After amending the claims as set forth above, claims 2-10, 12-17, and 21-32 are now pending in this application.

1. Rejection of Claims 2, 3, 6, 7, 14, 21, and 30-32 as Being Unpatentable Over Boling et al. (U.S. Patent Appl. Publ. No. 2006/0003809) in View of Curatolo et al. (U.S. Patent Appl. Publ. No. 2005/0136912)

In Section 3 of the Office Action, claims 2, 3, 6, 7, 14, 21, and 30-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boling et al. in view of Curatolo et al. In the Response to Arguments section of the Office Action, the Examiner stated in part:

In response to applicant's argument that there is no suggestion to combine references, . . . the Boling et al. (US Pub. No. 2006/0003809) reference was applied to teach, inter alia, wherein a device is programmed to effectuate a communication connection when a user depresses a key when the wireless telephony device is either powered on or off (and either a non-communications mode or a communications mode) (see page 1 [0027]). Hence the secondary reference Curatola et al. (US Pub. No. 2005/0136912) was properly applied to provide a teaching wherein it is preferable to use a manual switch, which may include at least two buttons activated simultaneously, to prevent accidental activation (see page 3 [0041]).

Applicants submit that Curatolo et al. is not available as a prior art reference for the teaching of "a manual switch, which may include at least two buttons activated simultaneously, to prevent accidental activation (see page 3 [0041])," as asserted by the

Examiner. Curatolo et al. was filed on November 8, 2004, which is after the filing date of the present application, which is April 27, 2001. Curatolo et al. claims priority as a continuation-in-part to Application No. 10/348,481, filed on January 20, 2003, now U.S. Patent No. 6,889,135 (the '135 patent), which is a continuation-in-part of Application No. 09/538,193, filed March 30, 2000, now U.S. Patent No. 6,510,380 (the '380 patent).

As stated in MPEP § 706.02(f), the "35 U.S.C. 102(e) date of a reference . . . is its earliest effective U.S. filing date, taking into account any proper benefit claims to prior U.S. applications under 35 U.S.C. 119(e) or 120 if the prior application(s) properly supports the subject matter used to make the rejection in compliance with 35 U.S.C. 112, first paragraph." Applicants submit that the subject matter used to make the present rejection was added as new matter in Curatolo et al., and is not supported in the prior-filed applications. The portion relied upon in Curatolo et al. in making the present rejection, paragraph [0041], states in part:

A manual switch may also comprise at least two buttons to be activated simultaneously to prevent accidental activation.

The above-cited portion of text was added as new matter to Curatolo et al., and support for this subject matter is completely missing from the disclosures of the '135 patent and the '380 patent, upon which Curatolo et al. relies for priority. Applicants have reviewed the disclosures of the '135 patent and the '380 patent and have found no portions that support the teaching of Curatolo et al. that "[a] manual switch may also comprise at least two buttons to be activated simultaneously to prevent accidental activation." Further, Applicants refer the Examiner to col. 4, lines 42-60 of the '135 patent, and point out that the paragraph contained therein recites the identical disclosure as that of paragraph [0041] of Curatolo et al., except for the portion of text cited above and relied upon by the Examiner in making the rejection.

Accordingly, Applicants submit that the 102(e) date for Curatolo et al. as used in the present rejection is November 8, 2004, which is after the filing date of the present application. Therefore, Curatolo et al. is not available as a prior art reference under 35 U.S.C. § 102(e), and Applicants respectfully submit that the rejection of claims 2, 3, 6, 7, 14, 21, and 30-32 under 35 U.S.C. § 103(a) as being unpatentable over Boling et al. in view of Curatolo et al. is

improper. Accordingly, Applicants respectfully request that the rejection of claims 2, 3, 6, 7, 14, 21, and 30-32 be withdrawn.

Further, even if Curatolo et al. were available as a reference for the present rejection, Applicants respectfully disagree with the Examiner's assertion that the secondary reference Curatolo et al. was properly applied. Applicants submit that there is no motivation to combine Boling et al. and Curatolo et al. because the proposed modification would render Boling et al. unsatisfactory for its intended purpose: "If [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no motivation to make the proposed modification." MPEP § 2143.01(V) (citing In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

Boling et al. is entitled "Emergency Phone With Single Button Activation" and discloses an emergency-use-only cellular phone that may be used to call either a "public emergency response service . . by pressing a single public emergency response button," or call a "private assistance center . . by pressing a single private assistance call button." ¶ [0009] (emphasis added). Boling et al. is intended to permit users to call either public or private assistance with the press of a single button on an emergency-use-only cellular phone.

Throughout the disclosure of Boling et al., the importance of this single-button functionality is emphasized. For example, at paragraph [0006], Boling et al. recites that "simplicity is critical. It is desirable that the user need not have to remember any phone numbers to dial, or which of many keys to press to initiate a call." Further, at paragraph [0013], Boling et al. recites that "[i]mplementing a single activation button to initiate all of these functions simplifies communication with the first emergency response service in a stressful situation." Further yet, at paragraph [0035], Boling et al. goes on to recite that one of the "primary benefits" of using only a single button is the "resulting simplicity of operation," and that "[s]ince only one button . . need be pressed to initiate a call, even very young children or persons with an aversion to most electronic devices can be taught how to use the phone 10 to easily summon help in an emergency." Further evidence of the importance that Boling et al. places on the single-button activation feature in an emergency-

use-only cellular phone may be found in paragraphs [0067], [0073] – [0074], and [0084], and in sole claim 1 (“a single button accessible through the housing”).

“[T]o modify Boling to include simultaneous depression of two input keys to effectuate a predetermined communication [according to Curatolo et al.],” as suggested by the Office Action at Section 3, would clearly render Boling et al. unsatisfactory for its intended purpose of providing users with single-button actuation capabilities. Therefore, Applicants submit that there is no motivation to combine Boling et al. with Curatolo et al., and that the Office Action has failed to establish a *prima facie* case of obviousness with respect to independent claims 6, 7, 14, and 21.

Applicants submit that each of independent claims 6, 7, and 14 are further patentable because the limitation of a “graphical user interface coupled to the processor,” is not taught or suggested by Boling et al. in view of Curatolo et al., even if the combination of the references was proper. As acknowledged by the Examiner, “Boling does not explicitly disclose a display having a graphical user interface coupled to the processor.” Office Action at Section 3.

As to Curatolo et al., it also does not teach or suggest a graphical user interface (GUI) coupled to the processor. The Office Action relies on inherency for the teachings of a GUI:

Curatola does meet the limitation surrounding having a graphical user interface coupled to the processor since page 3 [0041] and page 4 [0051] discloses that the signaling units may include or [be] incorporated within a PDA or cellular telephone, which inherently comprise a display having a GUI coupled to the processor.

(Response to Arguments, page 2 of Office Action).

First, a cellular telephone does not inherently comprise a display having a GUI coupled to a processor. It is undisputed that Boling et al. discloses a cellular phone but no display having a GUI coupled to a processor. “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference. . . . The mere fact that a certain thing may result from a given set

of circumstances is insufficient.”” MPEP § 2112(IV) (quoting In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed Cir. 1999)).

Second, Applicants respectfully submit that the Examiner has overbroadly interpreted Curatolo et al. in making the above assertion. Curatolo et al. is directed to a security or tracking system where a signaling unit may be physically attached to (e.g., “incorporated within”) various items, including a PDA or cellular telephone, for tracing purposes. However, in Curatolo et al. there is no teaching or suggestion that the processor of the signaling unit is coupled to the graphical user interface of the item within which it may be incorporated. Therefore, to modify Boling et al. with the teachings of Curatolo et al. would not result in the claimed subject matter, including a graphical user interface coupled to a processor. Rather, the proposed combination, if anything, would result in the device of Boling et al. being physically attached to an item to be tracked. Thus, the proposed combination of Boling et al. and Curatolo et al. fails to teach or suggest the limitation of a “graphical user interface coupled to the processor” in each of independent claim 6, 7, and 14.

Accordingly, for the reasons stated above, Applicants respectfully request that the rejection of independent claims 6, 7, 14, and 21, and corresponding dependent claims 2, 3, and 30-32 as being unpatentable under 35 U.S.C. § 103(a) over Boling et al. in view of Curatolo et al. be withdrawn.

2. Rejection of Claims 8 and 15 as Being Unpatentable Over Boling et al. and Curatolo et al. in View of Hess (U.S. Patent No. 5,777,551)

In section 4 of the Office Action, claims 8 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boling et al. and Curatolo et al. in view of Hess. Claim 8 depends from independent claim 7, and claim 15 depends from independent claim 14. As discussed above, independent claims 7 and 14 are believed to be patentable over Boling et al. in view of Curatolo et al. As to Hess, it does not make up for the above-noted deficiencies of Boling et al. and Curatolo et al. with respect to independent claims 7 and 14, from which dependent claims 8 and 15 depend. Accordingly, Applicants respectfully request that the rejection of claims 8 and 15 be withdrawn.

3. Rejection of Claims 4, 12, and 24-27 as Being Unpatentable Over Boling et al. and Curatolo et al. in View of Yasuda et al. (U.S. Patent No. 5,901,365)

In section 5 of the Office Action, claims 4, 12, and 24-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boling et al. and Curatolo et al. in view of Yasuda et al.

First, Applicants submit that, as discussed above, Curatolo et al. is not available under 35 U.S.C. § 102(e) as a prior art reference for purposes of the present rejection. Further, even if Curatolo et al. were available as a prior art reference, Applicants submit that the rejected claims are patentable over the cited references for the reasons stated below.

Applicants first point out that claims 28 and 29, which depend from independent claim 25, were not addressed by the Examiner in the Office Action and are believed to be patentable. In particular, claim 28 recites, in part, “wherein the software on the computing device includes software configured to run an electronic calendar in a non-communications mode,” which is not taught or suggested by the cited references. Applicants respectfully request clarification of where in the cited references the limitations of dependent claims 28 and 29 are disclosed.

Claim 25 is in independent form. Claims 26 and 27 depend from independent claim 25. Claim 25 recites a combination including, among other elements, “a display having a graphical user interface coupled to the processor,” which is not taught or suggested by Boling et al., Curatolo et al., and Yasuda et al., alone or in any proper combination. The Examiner relies on the teachings of Boling et al. and Curatolo et al. for the teaching of this limitation. As discussed above, the combination of Boling et al. and Curatolo et al. is not proper, and even if proper, fails to teach or suggest the above limitation. Accordingly, Applicants respectfully request that the rejection of independent claim 25, and corresponding dependent claims 26 and 27, be withdrawn.

Claim 4 depends from independent claim 7. Claim 12 depends from independent claim 14. Claim 24 depends from independent claim 21. As discussed above, independent claims 7, 14, and 21 are believed to be patentable over Boling et al. in view of Curatolo et al.

As to Yasuda et al., it does not make up for the above-noted deficiencies of Boling et al. and Curatolo et al. with respect to independent claims 7, 14, and 21, from which dependent claims 4, 12, and 24 depend. Accordingly, Applicants respectfully request that the rejection of claims 4, 12, and 24 be withdrawn.

4. Rejection of Claims 5, 13, and 23 as Being Unpatentable Over Boling et al. and Curatolo et al. in View of Asari et al. (U.S. Patent No. 6,031,470)

In section 6 of the Office Action, claims 5, 13, and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boling et al. and Curatolo et al. in view of Asari et al. Claim 5 depends from independent claim 7. Claim 15 depends from independent claim 14. Claim 23 depends from independent claim 21. As discussed above, independent claims 7, 14, and 21 are believed to be patentable over Boling et al. in view of Curatolo et al. As to Asari et al., it does not make up for the above-noted deficiencies of Boling et al. and Curatolo et al. with respect to independent claims 7, 14, and 21, from which dependent claims 5, 13, and 23 depend. Accordingly, Applicants respectfully request that the rejection of claims 5, 13, and 23 be withdrawn.

5. Rejection of Claims 10 and 17 as Being Unpatentable Over Boling et al. and Curatolo et al. in View of Kienberger (U.S. Patent No. 5,467,387)

In section 7 of the Office Action, claims 10 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boling et al. and Curatolo et al. in view of Kienberger. Claim 10 depends from independent claim 7, and claim 17 depends from independent claim 14. As discussed above, independent claims 7 and 14 are believed to be patentable over Boling et al. in view of Curatolo et al. As to Kienberger, it does not make up for the above-noted deficiencies of Boling et al. and Curatolo et al. with respect to independent claims 7 and 14, from which dependent claims 10 and 17 depend. Accordingly, Applicants respectfully request that the rejection of claims 10 and 17 be withdrawn.

6. Rejection of Claims 9 and 16 as Being Unpatentable Over Boling et al. and Curatolo et al. in View of Nilsson et al. (U.S. Patent No. 6,332,073)

In section 8 of the Office Action, claims 9 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boling et al. and Curatolo et al. in view of

Nilsson et al. Claim 9 depends from independent claim 7, and claim 16 depends from independent claim 14. As discussed above, independent claims 7 and 14 are believed to be patentable over Boling et al. in view of Curatolo et al. As to Nilsson et al., it does not make up for the above note deficiencies of Boling et al. and Curatolo et al. with respect to independent claims 7 and 14, from which dependent claims 9 and 16 depend. Accordingly, Applicants respectfully request that the rejection of claims 9 and 16 be withdrawn.

7. Rejection of Claim 22 as Being Unpatentable Over Boling et al. and Curatolo et al. in View of Shaanan et al. (U.S. Patent No. 6,332,084)

In section 9 of the Office Action, claim 22 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Boling et al. and Curatolo et al. in view of Shaanan et al. Claim 22 depends from independent claim 21. As discussed above, independent claim 21 is believed to be patentable over Boling et al. in view of Curatolo et al. As to Shaanan et al., it does not make up for the above note deficiencies of Boling et al. and Curatolo et al. with respect to independent claim 21, from which dependent claim 22 depends. Accordingly, Applicants respectfully request that the rejection of claim 22 be withdrawn.

8. Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for

such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

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